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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,056	06/06/2001	Akira Okano	209427US0	5636

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EXAMINER
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MERTZ, PREMA MARIA

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 11/04/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/874,056

Applicant(s)

OKANO ET AL.

Examiner

Prema M Mertz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-31 is/are pending in the application.
- 4a) Of the above claim(s) 20-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19 is/are allowed.
- 6) ☒ Claim(s) 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 12.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 1-14 have been canceled in Paper No. 13 (8/1/03). New claims 15-31 drawn to the elected invention are pending in the instant application.

#### ***Election/Restriction***

2. Applicant's election with traverse of Group II (claim 1-10) drawn to the polypeptide of amino acid sequence set forth in SEQ ID NO:4, in Paper No. 11 (6/26/03) is acknowledged. The traversal is on the ground(s) that the restriction is improper since the examiner has not shown that examination of the 6 major inventions of Groups I-VI, would entail a serious burden. This is not found persuasive because the searches for the 6 different polypeptides in the different Groups would not overlap. The invention listed in the different Groups do not relate to a single general inventive concept because they lack the same or corresponding special technical features for the following reasons. With respect to elected Group II drawn to the polypeptide of amino acid sequence set forth in SEQ ID NO:4, this polypeptide is structurally different from the polypeptides set forth in Groups I, III-VI. Any change of amino acid residues at any one or more positions in the polypeptide of SEQ ID NO:4 is considered, absent factual data to the contrary, a distinct polypeptide.

Inventions 1-VI are independent and distinct, each from the other, because each of the polypeptides are materially different products, which are structurally and chemically different, capable of separate manufacture and use. The products in the different Groups are physically and chemically distinct from each other, and if patentable would support separate patents.

Distinctness is further shown because a search of one of the polypeptides would not reveal art pertinent to the other and each of these products could be made and used without any one or

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more of the other products. Separate searches would be required for searching each of the polypeptide products eg. a search of the literature for the polypeptide of SEQ ID NO:4 would not necessarily reveal art for the polypeptide of SEQ ID NO:3, 5-7. Therefore, each of the polypeptides are not related and are properly restrictable in accordance with MPEP § 806.04 and MPEP § 808.01.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter as defined by MPEP. § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP. § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

The Groups as delineated in the restriction requirement (Paper No. 8, 3/10/03) are patentably distinct one from the other such that each invention could, by itself, in principle, support its own separate patent (as shown by the arguments put forth in the written restriction requirement).

The requirement is still deemed proper and is therefore made FINAL.

Claims 20-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim rejections-35 USC § 112, second paragraph***

3. Claim 31 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 31 is indefinite in the recitation of the term "variant thereof". This language is vague and indefinite because it is unclear what specifically is being claimed. How can both the protein and its variant consist of the amino acid sequence of SEQ ID NO:4? Therefore, the metes and bounds of the claim are unclear. It is suggested that the claim be amended to delete this limitation.

### ***Conclusion***

Claims 15-19 are allowable.

Claim 31 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

### ***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

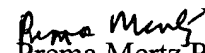
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Prema Mertz Ph.D.  
Primary Examiner  
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October 1, 2003